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09/550,471	04/14/2000	TODD ALLEN BERG	VS-42	8796

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EXAMINER

SNOW, BRUCE EDWARD

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 12/16/2003

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 09/550,471
Filing Date: April 14, 2000
Appellant(s): BERG ET AL.

MAILED

DEC 16 2003

GROUP 3700

Joel Weiss
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/27/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1 and 45 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,855,601	Bessler et al	1-1999
6,416,535	Lazarus	7-2002
5,843,164	Frantzen et al	12-1998
5,843,170	Ahn	12-1998

WO 99/04724 Strecker, 4-1999

WO 99/18887 Berg, 4-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-5, 9, 45-49, 53 are rejected *under 35 U.S.C. 102(e) as anticipated by (the anticipation portion was withdrawn in the final Office action), or, in the alternative under 35 U.S.C. 103(a) as obvious over Bessler et al (5,855,601).*

Referring to all figures, specifically figure 7, Bessler et al teaches a heart valve apparatus comprising a uni-directional valve portion 22, 63; a connector band 32, 50, or 62; and a plurality of fingers 64 which "*are oriented substantially parallel to the direction of blood flow*". Bessler et al specifically names elements 64 as "barbs". However, it is unclear as to the elements being "barbed fingers". Given the fact that the specification teaches "barb", it would have been obvious to one having ordinary skill in the art to have utilized such a configuration ("well-know sense" configuration known in the art, see definition in applicant's arguments in Amdt B, paper No. 11, page 6) for better anchoring.

Regarding barbs, see column 4, line 12.

Regarding the gasket, see element 25.

(11) *Response to Argument*

Background

The Examiner initially made a rejection of anticipation by or, in the alternative, obviousness in view of Bessler et al. Regarding the anticipation rejection under 35 U.S.C. 102, it was the Examiner's position that one having ordinary skill in the art of intraluminal fixation would interpret Bessler et al teaching of "barbs" as an anchoring means to inherently include an anchoring element with a barb or "barbed finger". In the final rejection, the Examiner withdrew the anticipation rejection leaving only the obviousness rejection.

Response

Appellants' present to the Board of Appeals a single issue, would it have been obvious to one having ordinary skill in the art to have replaced the heart valve fixation means (barbs 64) of Bessler with a "barbed fingers" configuration. It is the Examiner's position that it would have been very obvious to one having ordinary skill in the art based on the fact that barbed fingers would have been well know at the time of the invention.

Appellants argue that the modification to Bessler by the Examiner is merely hindsight; this is not true. The modification to Bessler is believed to have been obvious to one skilled in the prosthetic arts including soft tissue fixation and more specifically intraluminal fixation. The Examiner reasoning for the obvious modification:

"[G]iven the fact that the specification teaches 'barb', it would have been obvious to one having ordinary skill in the art to have utilized such a configuration ('well-know sense' configuration known in the art, see definition in applicant's arguments in Amdt B, paper No. 11, page 6) for better anchoring."

This rejection states *that* "such a configuration", a fixation element with a barb or "barbed finger", is well known in the art and it is advantageous because the configuration provides better anchoring or fixation within the vessel.

Appellants argue, (1) *"the Examiner does not provide evidence to show that the use of barbed fingers is common knowledge in the art"* and (2) *"it is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based."* It appears that appellants note Lazarus (6,416,535) as teaching "barbed fingers" in the art (see at least figure 11), however, incorrectly conclude that Lazarus was not prior art because it fails to predate April 23, 1999. Lazarus has continuity back to March 14, 1988 with two intervening patents! Lazarus (1) teaches barbed fingers were known in the art as shown in Figure 11 and, (2) was evidentiary support of record wherein the reference was used in a rejection of subcombination claims (now cancelled) directed to "a connector band" in paper No. 12. It should be noted that appellants' response to the rejection in view of Lazarus in paper No. 12 was not to argue it was not prior art, but simply canceled the claims. See appellants' "Reply to Office Action," paper No. 14.

The Examiner further notes Frantzen et al (5,843,164) that like Lazarus teaches (1) barbed fingers were known in the art (see at least Figure 10, elements 20 and 34) and, (2) was evidentiary support of record wherein the reference was used in a rejection

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of subcombination claims directed to "a connector band" in paper No. 12. Appellants' response to the rejection was again to simply cancel the claims. Finally, the Examiner notes Strecker (WO 99/04724), at least Figure 3; Ahn (5,843,170), at least Figure 19; and Berg (WO 99/18887), see at least page 11, lines 5-9; all of which were submitted by appellant in IDS, paper No. 3 and are evidence to the general knowledge to one having ordinary skill in the art.

It is the Examiner's position that the rejected under 35 U.S.C. 103(a) as being unpatentable in view of Bessler et al would have been obvious to one having ordinary skill in the art as supported by the evidence of general knowledge in the art above and should be maintained.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

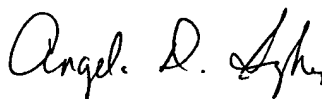


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December 10, 2003

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